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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,796	08/03/2004	Kevin Koch	43576.830008US1	4795
26582 7590 06/29/2007 HOLLAND & HART, LLP P.O BOX 8749 DENVER, CO 80201			EXAMINER DEBROW, JAMES J	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/710,796

Applicant(s)

KOCH ET AL.

Examiner

James J. Debrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/29/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 08 May 2007.
2. Claims 1-19, and 21-25 are pending in this case. Claims 1, 17 and 25 are independent claims.

Applicant's Response

3. In Applicant's response dated 08 May 2007, Applicant amended claims 1-6, 8-14, 17-19 and 22-25; canceled claim 20; argued against all rejections previously set forth in the Office Action.

Claim Rejections - 35 USC § 101

- 5) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 5-1) **Claims 1-16 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-16 and 25 sets forth non-functional descriptive material and fails to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a "useful, concrete and tangible" result.

Specifically, the language "computer readable medium" may differ in scope than a "computer readable storage medium". A "computer readable medium" may raise a possible issue of a "carrier wave", which is non-statutory.

The Examiner suggests that Applicant amend claims to recite a "computer readable storage medium."

Claim Rejections - 35 USC § 102

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6-1) Claims 1-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Przekop et al (US 200300789973, published Apr 24, 2003).

Regarding independent claim 1, Przekop teaches providing electronic versions of transcripts with links operably connecting the electronic versions of transcripts with electronic versions of exhibits, the method performed on a processor comprising the steps of: importing one or more electronic transcript files and one or more electronic exhibit files to a publisher; establishing an operable electronic link in at least one of the electronic transcript files between the at least one of the electronic transcript files and at least one of the electronic exhibit files; writing the one or more electronic transcript files and the one or more electronic exhibit files with the established operable electronic link to at least one memory file on the computer readable medium; and providing a means on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides

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storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16).

Regarding claim 2, Przekop teaches writing to a portable computer readable medium device. Przekop discloses downloading to a laptop (para 28).

Regarding claim 3, Przekop teaches portable computer readable medium device comprises a magnetic disk, an optical disk, a tape, or a removable hard disk (para 28).

Regarding claim 4, Przekop teaches writing to the computer readable medium that comprises a local memory file accessible from a local processor. For example, Przekop discloses the server automatically writing the files to a compact disk or desktop/laptop (para 28).

Regarding claim 5, Przekop teaches writing to the computer readable medium that comprises a remote memory file accessible from a local processor. For example, Przekop discloses a connection between a client and server, where the transcripts can be saved to a removable storage medium (para 16).

Regarding claim 6, Przekop teaches wherein the remote memory file is accessible

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through a network (paragraph 10, bottom "network such as the Internet").

Regarding claim 7, Przekop teaches wherein the network comprises at least one of a LAN, WAN, WLAN, Wi Fi network, Ethernet, Internet, World Wide Web, or an optical network (paragraph 10, bottom "network such as the Internet").

Regarding claim 8, Przekop teaches establishing a network connection between the at least one memory file and a local processor; and launching a viewer the provided means to view at the local processor. Przekop discloses clients with web browsers for viewing the transcript and synchronize video/audio (para 13), distributed by the server on a connection between client and server (para 16).

Regarding claim 9, Przekop teaches the step of establishing the operable electronic link comprises establishing a hyper-link from the at least one of the one or more electronic transcripts to at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom).

Regarding claim 10, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at a first reference to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

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Regarding claim 11, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at all references to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

Regarding claim 12, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at one or more user defined link points to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom), where the links are embedded in the transcript (para 11; para 24), embedded by a server.

Regarding claim 13, Przekop teaches a means to view step provides a means to view the electronic transcript and the operable electronic linked electronic exhibit substantially simultaneously. Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video ").

Regarding claim 14, Przekop teaches providing a means to view step further provides independent controls of the viewed electronic transcript and the operable electronic linked electronic exhibit. Przekop discloses a multi-frame web browser with video

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image presented in a first frame 401 and the transcript presented in a second frame 402

(para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video ").

The examiner interprets each frame (401 and 402) as being independent because the user can search the text frame without any action on the video frame.

Regarding claim 15, Przekop teaches providing an interface to allow a user to select one or more electronic transcripts to view. For example, Przekop discloses allowing a user to read each transcript (para 30 and 31). If a user is granted access, someone must have selected which transcript the designated user is allowed to view.

Regarding claim 16, Przekop teaches means to view electronic exhibit files selected from a group of files consisting of: video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS (para 16).

Regarding claim 17, Przekop teaches an electronic transcript and at least one associated electronic exhibit, the computer readable medium comprising: an importing module configured to import one or more electronic transcript files and one or more electronic exhibit files; an association module configured to establish an operable electronic link in the one or more electronic transcript files to provide an operable electronic link between at least one of the one or more electronic transcript files and the one or more electronic exhibit files; a writing module configured to write the imported electronic transcript files and electronic exhibit files with the operable electronic link established by the association module to at least one memory file in the computer readable medium; and a viewing module in the computer readable medium configured to allow a user to view the at least one memory file. For example, Przekop discloses a

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web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16). Additionally, the video can be imported to conventional litigation support software (para 28). The transcript file is converted to a .PDF and stored on a server along with the associated video/audio records (para 33), which the examiner equates to the claimed limitation of importing because storing a transcript on the server implies that the transcript was imported or copied onto the server and the conversion to PDF is the same as importing to a PDF. The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36), which is equivalent to the claimed viewing module.

Regarding claim 18, Przekop teaches a writing module is configured to write a file accessible to the computer readable medium over a network. For example, Przekop discloses saving records and transcripts to a storage medium across a connection between client and server (para 16).

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Regarding claim 19, Przekop teaches the writing module is configured to write the at least one memory file to a computer readable medium selected from a group of medium consisting of: a magnetic disk, and optical disk, a tape, a removable hard disk, a CDROM, or a DVD disk (para 28). For example, Przekop discloses saving records and transcripts to a storage medium, across a connection between client and server, such as a compact disk (para 16).

Regarding claim 21, Przekop teaches a viewing module is configured to view at least one of video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS (para 16).

Regarding claim 22, Przekop teaches the viewing module is configured to access the at least one memory file on the computer readable medium through a network connection (paragraph 10, bottom "network such as the Internet").

Regarding claim 23, Przekop teaches viewing module is configured to download the at least one memory file from the computer readable medium. Przekop discloses downloading the transcript and the video/audio record as a MPEG-1 file (para 36).

Regarding claim 24, Przekop teaches viewing module is configured to stream the at least one memory file from the computer readable medium. Przekop discloses transmitting the video/audio record as a scalable video stream (para 36).

Regarding claim 25, Przekop teaches a viewable electronic transcript and an associated electronic exhibit, the apparatus comprising: at least one memory file in a computer readable medium; and at least one processor, wherein the at least one memory file in the computer readable medium comprises: one or more electronic

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transcript files; one or more electronic exhibit files; and at least one operable link in the one or more electronic transcript files operably linking at least one of the one or more electronic transcript files and at least one electronic exhibit file of the one or more electronic exhibit files; the at least one processor comprises: a reader to read the at least one memory file from the computer readable medium; and a viewer to display the at least one memory file displayed, the viewer being configured to allow simultaneous display of the one or more electronic transcript and any operable electronically link electronic exhibits. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files discloses by Przekop (para 16). The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36). Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video "),

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which the examiner equates to the claimed "simultaneous display" because frames 401 and 402 are displayed at the same time.

Response to Arguments

4. Applicant's arguments filed 08 May 2007 have been fully considered but they are not persuasive.

Applicant argues *"the Examiner takes the position that the audio/video file is equivalent to the exhibit file. However, the applicant respectfully disagrees. In fact, Przekop et al. relates to only an electronic TRANSCRIPT file and is completely silent regarding an electronic exhibit file. In particular, Przekop et al. discloses providing synchronization of two versions of the electronic transcript file having essentially identical data contained in different formats, in other words, synchronizing the TEXTUAL electronic transcript file with the AUDIO/VIDEO electronic transcript file, a one-to-one link to a corresponding transcript audio/visual file. Thus, for at least this reason, claim 1 is not anticipated by Przekop et al."* (Remarks, p. 9)

The Examiner disagrees.

Applicant disagrees with the Examiner's position that the audio/video file is equivalent to the exhibit file, however the Examiner's position merely states what applicant has disclosed within the specification. As Applicant explicitly stated within the

specification, section 0021, "the exhibits included within the computer program product may be in various digital formats, including for example, video, audio, video/audio"

Therefore, based on Applicant's own definition, the Examiner concludes Applicant argument has no merit and is thereby considered moot.

Furthermore, the Przekop discloses each line of the transcript contains a selectable link to the video/audio record (0012). Since it is known and well established that court cases generally comprise a plurality of exhibits, the skill artisan can reasonably interpret the Przekop reference to be directed to not only one exhibit, but to a plurality of exhibits. Therefore, so as not to limit Przekop's invention to be unrealistically linked a single exhibit.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

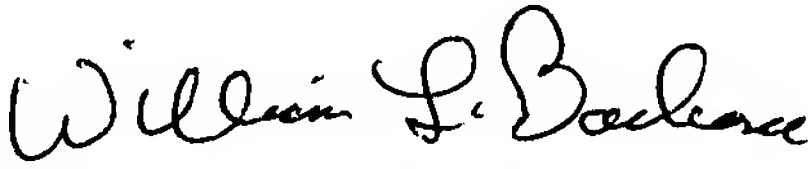
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAMES DEBROW
EXAMINER
ART UNIT 2176


WILLIAM BASHORE
PRIMARY EXAMINER